

II. REMARKS

Claims 1-63 are pending in this application. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. 1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

In the Office Action, claims 1-3, 12 and 13 are rejected under 35 U.S.C. §102(b) as being anticipated by Roe et al. (US patent no 5,989,236), hereafter “Roe.” Claims 4-11, 14-21, 29 and 43-55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roe. Claims 22-24, 26, 28, 30-42 and 60-63 are rejected under 35 U.S.C. §103(a) as being unpatentable over Allen et al. (US patent no. 6,489,956), hereafter “Allen,” in view of Roe. Claims 25 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Allen in view of Roe and further in view of Goyal (US patent no. 6,119,275), hereafter “Goyal.” Claims 56-59 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roe in view of Glaug et al. (US patent no 6,258,076), hereafter “Glaug.” This rejection is respectfully traversed for the reasons stated below.

I. REJECTION OF CLAIMS 1-7, 9-16, 18-24, AND 26-63 UNDER 35 U.S.C. § 102(b)

In the Office Action, claims 1-7, 9-16, 18-24, and 26-63 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Roe. In a recent non-precedential opinion, the Court of Appeals for the Federal Circuit explained that “[a] determination that a claim is anticipated under 35 U.S.C. § 102 involves two analytical steps.” *In re Simpson*, 2003 U.S. App. LEXIS 7278, *7 (Fed. Cir. 2003). The claim language first must be interpreted, and then each element of the claim is compared to a prior art reference. *Id.* Because the Office has erred in comparing the present invention to the prior art reference, Applicants respectfully request withdrawal of this rejection.

Applicants respectfully submit that Roe fails to disclose the claimed back guard. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); see MPEP § 2131, p. 2100-70. The Office cites Roe’s background statement that “...it would be advantageous to provide an absorbent article which can be fitted to a wearer in a high-back configuration...” as allegedly disclosing the claimed back guard. Roe provides a fold-down waist feature that fastens about the waist of a wearer. Col. 7, line 7. At a least a portion of the waist feature flap may be folded downward to reduce the length of the diaper or may be left in the traditional configuration. Col. 7, line 25-28. (Abstract). When the diaper is in the traditional configuration, an adhesive on one side of the ear flap in the back of the diaper attaches to the front of the diaper. Col. 7, line 29-34. When the diaper is in the folded configuration, an adhesive on the opposite side of the same ear flap in the back of the diaper attaches to the same

place in the front of the diaper. Col. 7, line 34-39. Thus in either configuration, the Roe diaper is designed such that the top front of the diaper is aligned with the top back of the diaper. Figure 3. The present invention includes a back guard that extends vertically from the rear portion of the diaper. Thus Roe does not have a back guard as contained in the present invention.

Even in the “high-back configuration” (col. 1, line 42-45) cited by the Office, Roe does not disclose the back guard that is a part of the current invention. The high-back configuration refers only to the ability to unfold the waist feature of the Roe diaper into a traditional configuration, which would obviously extend the diaper higher up the waist than in the folded configuration. However, even in the high-back configuration the back of the Roe diaper is designed to attach to the front in such a way that the top of the diaper is at the same vertical point in the front as in the back. This is in contrast to the current invention in which the back guard extends vertically from the rear portion to a middle back area of a user. Furthermore, the fold-down portion of the Roe diaper is consistently referred to as the waist feature. By definition the term waist feature conveys the meaning that the fold is designed to be at or about the waist. It can be deduced from the natural meanings of the terms that a “high-back configuration” of a “waist feature” simply means that the diaper is worn slightly higher on the waist or even slightly higher than the waist. Roe’s disclosed waist feature simply does not encompass the region of the middle back. Conversely, the back guard as disclosed in the present invention extends vertically from the rear portion to a middle back area of a user. The back guard in these claims, in contrast to Roe, is extended vertically such that it is noticeably higher than the front. Furthermore, the back guard extends to the well-defined middle back area of the user, as opposed to the nebulous “high-back configuration” of Roe.

The Office also incorrectly cites a feature that allows the Roe diaper to increase its longitudinal length as justification for its rejection. The Roe diaper uses a fold up waist feature to accomplish this task. Col. 9, line 33. However, the fold up waist feature in Roe is still designed such that the top of the back portion of the diaper is at the same vertical height as the top of the front portion. Furthermore, the portion of the diaper that the Office refers to is still called a “waist feature.” As stated above, a waist feature is designed to be at or near the waist. Roe fails to disclose a back guard that “extend[s] vertically... to the middle back area of a user.” The back guard as contained in the present invention is designed to extend vertically from the rear portion of the garment and to extend to the middle back area of the user. Thus, the Roe diaper clearly does not anticipate the incontinence garment as included in the present invention. Accordingly, Applicants respectfully request that the Office withdraw its objection under 102(b).

The various dependent claims are patentable for these reasons as well as for their own patentable features. As a result, Applicants respectfully request withdrawal of this rejection.

II. REJECTION OF CLAIMS 4-11, 14-21, 29 AND 43-55 UNDER 35 U.S.C. § 103(a)

In the Office Action, claims 4-11, 14-21, 29 and 43-55 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Roe. Applicants herein incorporate the arguments presented above with respect to independent claim 1 from which claims 4-11 depend. In particular, since Roe does not teach all the claim limitations of claim 1, Roe also fails to teach all the limitations of the dependent claims 4-11. As a result, Applicants respectfully request withdrawal of this rejection.

With specific regard to independent claims 14, 29, 43 and 53, Roe fails to teach a back guard extending vertically from the rear portion to a middle back area of a user. As stated above, in both the fold-down and the so called high-back configuration, the Roe diaper is designed such that the top of the front part of the diaper is aligned with the top of the back part of the diaper, as opposed to the back guard being noticeably higher than the front as in the referenced claims of the present invention. As also stated above, the so-called high-back configuration of Roe is simply the fold-down feature in a configuration in which it is not folded down, i.e., a regular diaper. Furthermore, as stated above, the fold-down portion of the Roe diaper is called a waist feature, indicating that it is designed to be worn at or about the waist. In the present invention the back guard extends to the middle back area, which is much higher than the waist. Thus, the high-back configuration of Roe is not substantially similar to the waist guard as contained in the present invention.

With regard to claims 10, 11, 14, 20, 21, 29, 43-47 and 50-53 the Office argues that a back member length range of 1.0 to 10.0 inches is obvious in light of Roe's high-back configuration. As stated above Roe does not disclose a back guard. The high-back configuration of the waist feature in Roe simply allows the Roe diaper to be worn as a regular diaper at or about the waist rather than being folded down. In contrast, the present invention may contain a back guard extending vertically with a length of 1.0 to 10.0 inches. This range of lengths is specifically designed to provide the optimum range of lengths to allow the back member to extend to the middle back of the user, depending on the user's size. Accordingly, applicants respectfully request that the Office withdraw its rejection.

With regard to claims 22-24, 26, 28, 30-42 and 60-63 the Office is incorrect in equating the extension panel in Allen with the back guard as contained in the present invention. The extension panel in Allen is designed to "...be wrapped around the waist with the tabs brought into alignment and in overlapping relation to the complementary fastener bar at the opposite end of the diaper..." col. 4, line 60-63. Since the referred to tabs are shown to be at the top of the extension panel in FIG. 3A and FIG. 3B the coupling of these tabs would produce a diaper top that is the same height in the back as in the front as shown in FIG. 3C. Furthermore, the extension panel in Allen is designed to be "wrapped around the *waist*" (emphasis added). Col. 4, line 60. Conversely, the back member in the current invention is designed with a back guard extending vertically from the rear portion. The back guard is designed to extend to the middle back area of the user. Since Allen does not teach a back guard such as the one included in the present invention, the Allen diaper cannot be used in support of the Office's obviousness rejection. Accordingly, applicants respectfully request that the Office withdraw its rejection.

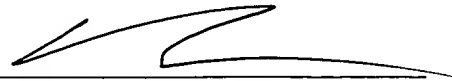
The Office is also in error with respect to its rejection of claim 56-59 as being unpatentable over Roe in view of Glaug et al. As argued above, Roe does not disclose the back guard as included in the present invention. Furthermore, Glaug does not disclose a front guard as included in the present invention. The second barrier panel in Glaug does not disclose a front guard as argued by the Office but instead discloses a barrier panel that uses a "...skin friendly adhesive [to] form a liquid-resistant seal with the being's skin..." (col. 4, line 8-9). This second barrier panel is designed to be placed at the front waist portion (col. 4, line 2) of the article, and the front waist portion is designed to be worn "...disposed adjacent the being's lower abdominal region..." (col. 3, line 33). It is clear that an adhesive engaged second barrier panel has nothing

in common with the front guard extending vertically from the front portion to a middle chest area of a user as described in the current invention. Furthermore, while the Glaug second barrier panel is a waist portion designed to be worn in the lower abdominal region, the front guard as included in the present invention is designed to extend vertically to the middle chest area of the user. For the above stated reasons, the second barrier panel in Glaug is not equivalent to the front guard as found in the present invention, and the Office cannot use Glaug to support its rejection. Accordingly, applicants request that the rejection be withdrawn.

III. CONCLUSION

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,



Ronald A. D'Alessandro
Reg. No.: 42,456

Date: 4/11/07
Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)